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EXAMINER

PILLAI, NAMITHA

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DONNA SUE SHAW, GREGORY SCOTT KLABISH, and GAIL
ELAINE SLAPIKOFF

Appeal 2016-007152
Application 12/039,789
Technology Center 2100

Before THU A. DANG, JOHN D. HAMANN, and ALEX S. YAP,
Administrative Patent Judges.

DANG, *Administrative Patent Judge.*

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) of the Examiner's second non-final rejection of claims 1–7, and 21–32, which are all of the pending claims. Claims 8–20 were previously canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

A. THE INVENTION

According to Appellants, the invention relates to “collaborative management of activities occurring during the lifecycle of a meeting” (Spec. ¶ 5).

B. ILLUSTRATIVE CLAIM

Claim 1 is exemplary:

1. A method comprising:

- providing an agenda interface configured to allow an originating meeting participant to generate an agenda for a meeting;
- locally storing the agenda in a workspace in a computer associated with the originating meeting participant, the computer having a copy of a collaboration program facilitating the workspace;
- transmitting a copy of the workspace to computers used by other meeting participants of the meeting, the transmitted copies of the workspace being locally stored in the computers used by the other meeting participants, which individually have a copy of the collaboration program;
- providing a summary interface configured to allow the originating meeting participant to generate a summary of the meeting;
- storing the summary of the meeting in the workspace in the computer used by the originating meeting participant;
- transmitting a copy of the summary of the meeting in the workplace to the computers used by the other meeting participants of the meeting;
- detecting, by the collaboration program, a change in at least one of the copies of the summary of the meeting locally stored in the computers used by the other meeting participants; and
- automatically synchronizing, by the collaboration program, the detected change in the summary of the meeting to the copies of the workspace locally stored in the computers used by the originating meeting participant and the other meeting participants.

C. REJECTION

Claims 1–7 and 21–32 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Oral et al. (US 2008/0162244 A1; pub. July 3, 2008) (“Oral”).¹

II. ISSUES

The issues before us are whether the Examiner erred in finding that Oral teaches “detecting, by the collaboration program, a change in at least one of the copies of the summary of the meeting locally stored in the computers used by the other meeting participants;” and “*automatically synchronizing, by the collaboration program, the detected change in the summary of the meeting to the copies of the workspace locally stored in the computers used by the originating meeting participant and the other meeting participant.*” (Claim 1, emphasis added).

III. ANALYSIS

Appellants contend Oral “does not disclose synchronizing the reordered agenda between the attendee that reordered the agenda and both the meeting host and ‘the other meeting participants’” (App. Br. 15). In particular, Appellants contend, “as clearly set out in Oral’s description, the reordered agenda is passed back to the meeting host, who can either accept or reject the reordered agenda” (*id.*). According to Appellants, “manual intervention by the Host is needed in order for Oral’s re-ordered agenda be transmitted to the client devices,” and thus, “Oral’s teaching of sending out

¹ In the Answer, the Examiner withdraws the rejection of claims 1–7 and 21–32 under 35 U.S.C. § 112, first paragraph. Ans. 2.

the re-ordered agendas cannot possibly be read as ‘automatically synchronizing’ by Oral’s meeting scheduling service 103.” (Reply Br. 2).

After reviewing the record on appeal, we find the preponderance of evidence supports Appellants’ position. Even though we agree with the Examiner that “Oral discloses generating a first meeting agenda which reads on a summary of the meeting,” “the attendee reordering the agenda items at their client device,” and “the host then sending the other invitees the newly ordered agenda,” which “results in a change to the local copy stored on the client device of the other meeting participants” (Ans. 2–4), we do not find, in the referenced portions of Oral, any teaching of “*automatically synchronizing, by the collaboration program, the detected change* in the summary of the meeting to the copies of the workspace locally stored in the computers used by the originating meeting participant and the other meeting participants,” as required by claim 1. In particular, as the Examiner finds, the *host*, in Oral, sends the other invitees the newly ordered agenda. *Id.*

Although “the PTO must give claims their broadest reasonable construction consistent with the specification[,] . . . claims should always be read in light of the specification and teachings in the underlying patent.” *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1259–60 (Fed. Cir. 2010) (internal citations and quotation omitted). We find one of ordinary skill in the art, in light of the Specification and plain meaning of the claim language, would have understood “automatically synchronizing, by the collaboration program” to encompass the collaboration program, without human intervention, synchronizing the detected change to computers used by the originating meeting participant and the other meeting participants. We find the Examiner construes “automatically synchronizing, by the collaboration

program” too broadly and unreasonably by construing the phrase to include that “[t]he host determines with the pre-defined agenda is accepted in response to which the data is automatically synchronized with the meeting invitees and the agendas in their local client device.” (Ans. 4, emphasis added). Nor has the Examiner cited to any portion of the Specification to reasonably allow for broadening the ordinary meaning of “automatically synchronizing, by the collaboration program” to include such intervention by the host.

Although we are mindful that the claimed method recites the transitional term “comprising” which indicates that the claim is open-ended and allows for additional steps (*Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368 (Fed. Cir. 2003)), the question is whether the Examiner’s determination of the scope of claims, though broad, is a reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). (See MPEP § 2111).

Here, the “automatically synchronizing” step requires the automatic synchronizing of the detected change by the collaboration program “to computers used by the originating meeting participant and the other meeting participants.” We find such interpretation of the “automatically synchronizing, by the collaboration program” to also comprise 1) a human intervention by the host to accept the change at the computer used by the host (the originating meeting participant), and then 2) the human intervention by the host to send the change to the computers used by the other meeting participants, to be overly broad and unreasonable. That is, such interpretation would not be the broadest, *reasonable* interpretation “in

light of the specification as it would be interpreted by one of ordinary skill in the art.” *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d at 1364.

Accordingly, we are persuaded that the Examiner erred in finding Oral teaches “automatically synchronizing, by the collaboration program, the detected change in the summary of the meeting to the copies of the workspace locally stored in the computers used by the originating meeting participant and the other meeting participant” (claim 1).

On this record, we are constrained to reverse the Examiner’s 35 U.S.C. § 102 rejection of claims 1, claims 21 and 30, reciting similar limitations, and claims 2–7, 22–29, 31, and 32, depending respectively on claims 1, 21, and 30, over Oral.²

² Because a rejection of the claims under § 103 is not before us on appeal, we do not reach and express no opinion as to whether the claims might be obvious over the teachings and suggestions of the Oral reference, considered alone, or considered in combination with one or more additional references. In the event of further prosecution, we invite the Examiner’s attention to Appellants’ proffered evidence, and leave it to the Examiner to determine whether these claims should instead be rejected under 35 U.S.C. § 103(a). In particular, we leave it to the Examiner to determine whether providing a mechanical or automatic means to replace manual activity to accomplish the same result would be an obvious improvement. *See In re Venner*, 262 F.2d 91, 95 (CCPA 1958). We also leave it to the Examiner to determine whether automatically synchronizing a detected change would have been uniquely challenging or otherwise beyond the level of skill possessed by ordinarily skilled artisans. *See Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007). While the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. *See* MPEP § 1213.02.

V. CONCLUSION AND DECISION

We reverse the Examiner's rejections of claims 1–7 and 21–32 under 35 U.S.C. § 102(e).

REVERSED